

REMARKS

Applicant has carefully considered the Examiner's Office Action and has amended the claims responsively to define the invention in clearer form and to distinguish patentably from the prior art.

Applicant has also amended the specification to provide for the required section headings and to avoid reference to specific claim numbers.

Thus, applicant has replaced the cancelled claims 1-4 with the newly-submitted claims 5-15.

These new claims 5-15 include the subject matter and limitations which are not to be found in the prior art.

In considering the reference patent to Neumann (4,974,707) which has been applied by the Examiner, applicant notes that whereas this reference patent has elements in common with applicant's invention, this reference to Neumann does not disclose a secondary piston (9) which is arranged hydraulically in one of the bypasses, as provided by applicant and recited in the new base claim 5.

The subject matter for this secondary piston (9) is described in the specification on page 3, paragraph 2, sentence 1. This subject matter is also shown clearly in applicant's Figure 1 where the secondary piston 9 is arranged or accommodated in the beaker-shaped hollow space 11.

The reference patent to Neumann does not disclose at all any secondary piston in any of the bypass channels 153, 154. As a result, a person working in the art could not obtain from the reference patent to Neumann, the technical solution provided by applicant and defined in the new base claim 5.

There is also no hint or anticipation in the reference patent to Neumann on the possibility of using a secondary piston in addition to the main damping piston or primary piston 2.

It is submitted, therefore, that applicant's invention provides for a structure that is new over the prior art.

Thus, applicant's invention provides for a first bypass which is formed from bores 18 and 17 and which surrounds directly the damping piston 2. This bypass formed from the bores 18 and 17 has no bypass piston. Instead, this bypass is provided solely with the slider 14 and its channel 17 having opening cross-section 19.

In the second bypass which is formed by the bore 10, the beaker-shaped space 11 and the outlet 12, there is provided a secondary piston 9. This bypass piston has passive damping valves, as may be seen from Figure 1. As a result, damping fluid flowing through this second bypass must flow through these damping valves. Accordingly, the second bypass exhibits damping characteristics.

The reference patent to Neumann does not at all disclose a secondary piston in any of the bypass channels 153, 154. As a result there can be also no damping characteristics in these bypass channels 153, 154 in this reference patent to Neumann.

In applicant's invention, on the other hand, the first bypass which is formed by the bores 18, 17 and by the slider 14 opened by the bore 17, forms a permanently opened bypass which is surrounded directly by the damping piston 2. Due to this first bypass, flow medium surrounded by the damping piston 2 can flow from the chamber 4 into the chamber 3 and in reverse, under slow strokes of the damping piston 2.

At the same time, applicant's invention provides that the second bypass which has the secondary piston 9, forms a bypass connection between the chambers 4 and 3. These chambers possess damping characteristics because the secondary piston 9 exhibits passive damping valves which are shown in Figure 1.

The reference patent to Neumann cannot possibly carry out the function of applicant's invention because this reference

patent does not disclose the corresponding secondary piston 9 as provided by applicant.

Applicant's invention provides for a new improvement over the prior art due to the arrangement of a secondary piston 9 in one of the bypasses, and the new subject matter is recited in the new base claim 5. As a result, the new base claim 5 provides for a novel combination which a person working in the art cannot derive from the reference patent to Neumann. As noted above, none of the bypass channels 153, 154 of the reference patent to Neumann discloses an additional or secondary piston with supplemental damping valves.

The advantages obtained from applicant's invention cannot be obtained from the reference patent to Neumann because applicant's novel construction is not disclosed in this reference patent.

It is submitted that applicant provides for a new and marked improvement over the prior art.

Since the claims in the application define clearly the differences between applicant's invention and the prior art, it is believed that the claims should be found allowable.

Applicant has carefully studied the remaining references which were cited by the Examiner for being of interest but not applied in the case. After detailed analysis of these additional references, applicant has concluded that they are entirely unrelated to applicant's invention, and they do not anticipate the novel features of applicant's arrangement.

The Examiner's attention is respectfully directed to the court decision in the case of *In re Bisley* (94 U.S.P.Q. 80, 86), in which it was decided that patentability is gauged not only by the extent or simplicity of physical changes, but also by the perception of the necessity or desirability of making such changes to produce a new result. When viewed after disclosure, the changes may seem simple and such as should have been obvious to those in the field. However, this does not necessarily

negate invention or patentability. The conception of a new and useful improvement must be considered along with the actual means of achieving it in determining the presence or absence of invention. The discovery of a problem calling for an improvement is often a very essential element in an invention correcting such a problem. Though the problem, once realized, may be solved by use of old and known elements, this does not necessarily negate patentability.

Furthermore, in the case of *ex parte* Chicago Rawhide Manufacturing Company (226 U.S.P.Q. 438), the Patent Office Board of Appeals ruled that the mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal, is not by itself, sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device. The Examiner has not presented any evidence to support the conclusion that a worker in this art would have had any motivation to make the necessary changes in the reference device to render the here-claimed device unpatentable.

In the case of *United Merchants and Manufacturers Incorporated versus Ladd* (139 U.S.P.Q. 199), the District Court ruled that although from simplicity of device and with advantage of hindsight, one might off-handedly be of opinion that anyone should have been able to make invention after studying prior art, claims are allowed since none of the references discloses or suggests the concept which is the crux of the invention.

Finally, in the case of *Menge and Drissen* (181 U.S.P.Q. 94), the Court ruled that progress in crowded arts, usually made in small increments, is as important as it is in arts at the pioneer stage; constitution envisages and seeks progress in useful "arts," not just in those more esoteric or scientific.

In amending the claims, applicant has formulated the new claims to meet the provisions of 35 U.S.C. 112 with respect to definiteness and antecedent basis, in addition to including the subject matter and limitations not disclosed or anticipated by the prior art.

In view thereof, it is respectfully requested that the claims in the application be allowed and the case be passed to issue.

I HEREBY CERTIFY that this correspondence is being deposited with the United States Postal Service at the time of its mailing, addressed to: Commissioner of Patents and Trademarks, Washington, D. C. 20231, in accordance with the provisions of 37 C.F.R. 1.53.

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